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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,532	01/10/2001	Geoffrey B. Rhoads	60244	9755

23735 7590 10/21/2003

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
SUITE 100
TUALATIN, OR 97062

EXAMINER

NGUYEN, SIMON

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 10/21/2003

\$7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,532

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

SIMON D NGUYEN

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Walsh et al. (6,144,848).

Regarding claim 6, Walsh discloses a handheld device using for purchase of an item (abstract, fig.4-5), comprising: step of optically identifying a desired item; and step for communicating an identity of the item to a remote computer (fig.7, column 9 line 55 to column 10 line 20, column 16 line 24).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. (6,144,848) in view of Manico et al. (6,628,326).

Regarding claim 1, Walsh discloses a handheld telephone device (figs. 1, 4-5) including a microphone, a modulator, and an RF amplifier, the device serving to receive audio and transmit and RF signal conveying audio modulation, an improvement comprising an optical sensor (bar code reader 121 having plural sensing elements and producing image signals (fig.1, 4-5, column 1 line 56 to column 2 line 10, column 16 line 24). However, Walsh does not specifically disclose a lens.

Manico discloses a wireless communication device (abstract) including an image sensor (30) having a lens (20) for imaging an object onto the sensor (fig.1, 4, column 3 lines 1-30, column 4 lines 34-53). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Walsh, modified by Manico to capture images in order to improve the system performance.

Regarding claim 2, Walsh further discloses a decoder for decoding plural bits (a digital signal uses bits) (column 14 lines 11-23).

Regarding claim 3, this claim is rejected for the same reason as set forth in claim 1, where the screen of the telephone device is used to present image data originating from the image capture device (figs.4, 5a of Manico).

Regarding claims 4-5, Walsh further discloses a CPU 122 as a processing unit (fig.1A, column 16 line 66 to column 17 line 14).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Parulski reference (6,122,526) discloses a wireless telephone implementing with a camera to capture and to produce images on a display (abstract, figs. 7-9); the Reitmaa reference (6,424,843) discloses a wireless telephone implementing with a camera to capture and produce images on a display (abstract, figs. 8-9).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (703) 308-1116. The examiner can normally be reached on Monday-Friday from 7:00 AM to 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

Application/Control Number: 09/758,532
Art Unit: 2685

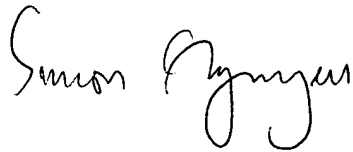
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(703) 872-9314, (for formal communications intended for entry)

Hand-delivered response should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Simon Nguyen

October 15, 2003

A handwritten signature in cursive script that reads "Simon Nguyen". The signature is written in black ink and is positioned below the typed name and date.